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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,312	02/24/2004	Eduard K. de Jong	SUN-P9179	3445
24209 7590 01/25/2007 GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940			EXAMINER LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/786,312

Applicant(s)

DE JONG, EDUARD K.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-63 is/are allowed.
- 6) ☒ Claim(s) 64-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/2005; 2/2006; 8/2006 & 5/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The amendment filed on 10/5/2004 has been entered. The information disclosure statements filed on 7/11/2005, 2/16/2006 and 8/4/2006 all have been considered. Claims 1-68 remain for examination.

### ***Allowable Subject Matter***

Claims 1-63 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose a method for processing an application identifier (AID) for an application installed on a smart card wherein the AID comprising a registered application provider identification (RID), comprising the steps of: (i) determining the RID for an application from the AID of the application; (ii) generating a network resource identifier; (iii) transmitting a request to the network resource using the network resource identifier; (iv) receiving a response, wherein the response comprising material for use in handling the application on the smart card; and having the functions and characteristics as recited in claim 1. The prior art also fails to disclose the limitations of claim 26, 38, and 39.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 64-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Ashizawa et al. (Ashizawa et al. – 6,976,635; herein after referred to as Ashizawa).

Regarding claim 64, Ashizawa shows a server for processing an application AID for an application installed on a smart card comprising: (i) a network interface operable to receive the RID over a network (figure 1, server communication means 2011); (ii) a processing facility operable to identify material based on the received RID (see descriptions of embodiments 1-12; wherein the server obtain and process attribute information from IC cards). As can be seen, Ashizawa discloses the claimed invention. The following quotes that are relied on are herein provided for further reviews (also see descriptions of related figure or embodiments):

As shown in FIG. 1, a server 1001 and an IC card terminal 1002 are connected with a network to each other, and the IC card terminal 1002 is connected to a plurality of IC cards, an IC card 1003, an IC card 1004 and an IC card 1005 through terminals or electrically through a connection apparatus. In the IC card terminals, there are so called a contact type and a noncontact type, but the kinds of types have nothing to do with the present invention. In FIG. 1, for simplicity, the connection apparatus is expressed with full lines connecting the IC card terminal 1002 and the IC card 1003, the IC card 1004 and the IC card 1005.

FIG. 2 is a drawing showing the details of an example of the configuration of the IC card terminal 1002 shown in FIG. 1. In other words, the examples of the principal functions of the IC card terminal 1002 are shown in the figure. A control means 2012 controls the operations of respective means in the IC card terminal. The IC card terminal is connected to a server 1001 through a server communication means 2011, and is connected to the IC card 1003, the IC card 1004 and the IC card 1005 through an IC card communication means 2009.

A server communication means 2011 is a means to transmit signals to the server 1001. For these IC card communication means 2009 and server communication means 2011, a communication means for an ordinary IC terminal suffices.

An IC card terminal obtains an IC-card-application list and the attribute information of IC-card applications of IC cards shown with a variable *i* by means of the "IC-card-application list and the attribute-information-attainment means" 2014. The above-mentioned attribute information of an IC-card application is, as shown in FIG. 3, stored in the "IC card application list and the attribute information of an IC card applications storage means" 3005. Therefore, it is possible to obtain the IC-card-application list and the attribute information of an IC card applications from the attribute-information-storage means 3005 owned by an IC card. The above-mentioned attribute information of an IC-card applications means the following: a public key of an IC card application, the name or AID (application identifier) of an IC card application, the name or ID of the manufacturer of an IC card application, the name or RID (registered application provider identifier) of an IC-card-application issuer, etc. The attribute information of an IC-card application uses a designated number of pieces of the attribute information in correspondence to the contents of a service.

When T expresses an IC card, an item or more than 2 items among the items cited in the following are accepted: an IC-card ID, an IC-card public key, the name or ID of a card holder, the name or ID of an IC-card issuer, the name or ID of an IC-card manufacturer. When T expresses an IC-card application, an item or more than 2 items among the items cited in the following are accepted: a public key of an IC-card application, a name or ID of an IC-card application, that is called AID (application identifier), a manufacturer's name or ID of an IC-card application, a issuer's name or ID of an IC-card application, that is called RID (registered application provider identifier). At an attribute-information-extraction step 15002, designated information is extracted. When T expresses an IC card, an attribute information is obtained from the IC-card-attribute-information-storage means 3004 by means of an IC-card-attribute-information-obtainment means 4005. When T expresses an IC-card application, an attribute information is obtained from the IC-card-application list and attribute-information storage means 3005 by means of the IC-card-application list and attribute information-obtainment means 4011. And at the next an associated-IC-card-application-attribute-information-set step 15003, the extracted information is considered to be an associated-IC-card-application-attribute information.

(51) Before the issue or at the time of issue, the correspondence conditions of IC cards and the applications are decided. The data of the correspondence conditions are stored in an IC card or in a server. In a case where after the issue of an IC card an application is to be issued, there is a

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case where the data of correspondence conditions are extracted from an IC card on the requested side for association.

Regarding claims 65-66, see the constructions and operational details of the IC card as described and shown in figures 2-4 wherein the IC includes means for storing IC application list and attribute information that would embrace all limitations set forth in these claims.

Regarding claim 66, see the discussions regarding claim 64. Specifically, Ashizawa discloses in the background section that IC card information are usually communication and store in codes that would embrace all limitations set forth in this claim.

Regarding claim 68, see the discussions regarding claim 64.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**January 22, 2007**